



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,421	03/13/2001	Anthony Angelo Agoni	ALAW.001A	3477
20995	7590	10/21/2005	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			BLECK, CAROLYN M	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			3626	

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/808,421

Applicant(s)

AGONI ET AL.

Examiner

Carolyn M. Bleck

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 74 and 75 is/are pending in the application.
- 4a) Of the above claim(s) 7-73 and 76-78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 74 and 75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6 August 2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the election filed 23 September 2005. Claims 1-78 are pending. Claims 1-6 and 74-75 have been elected. Claims 7-73 and 76-78 have been cancelled.

Election/Restrictions

2. Applicant's election without traverse of claims 1-6 and 74-75 in the reply filed on 23 September 2005 is acknowledged. Claims 7-73 and 76-78 have been cancelled.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-6 and 74-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claims 1 and 2 recite "a first service-enhancing system" and "a second service-enhancing system." Claim 74 recites "a communication-enhancing system." It is respectfully submitted that it is unclear what "a first service-enhancing system," "a second service-enhancing system," and "a communication-enhancing system" are

Art Unit: 3626

composed of. What are the elements of these systems? Are they computer hardware or software? How are they able to enhance a service?

In addition, claim 2 recites "enhancing the availability to said at least some potential clients of said listing information." It is unclear how the availability is enhanced. What steps are performed to enhance the availability to potential clients?

(B) Claims 3 and 75 recite "receiving an agreement from said service provider to adhere to certain standards of care in providing services to each client obtained as a result of said making said listing information available, said certain standards being more specific, or higher than those generally accepted or legally required to practice in the industry of said service provider." The terms "said certain standards being more specific, or higher than those generally accepted or legally required to practice in the industry of said service provider " in claims 3 and 75 are relative terms which renders the claim indefinite. The terms "more specific or higher" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 3626

6. Claims 1-6 and 74-75 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

(A) For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1 and 3 only recite abstract ideas. The recited steps of merely generating listing information identifying a service provider, making said listing information available to potential clients of said service provider, and receiving an agreement from said service provider to use a first service-enhancing system to provide services to each client obtained as a result of said making said listing information available or receiving an agreement from said service provider to adhere to certain standards of care in providing services to each client obtained as a result of said making said listing information available, said certain standards being more specific, or higher than those generally accepted or legally required to practice in the industry of

Art Unit: 3626

said service provider do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to receive an agreement from a service provider.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention generates a listing of service providers and allows the service providers to enter into agreements (i.e., repeatable) used as a method for facilitating services (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention as a whole, is not within the technological arts as explained above, claims 1 and 3 are deemed to be directed to non-statutory subject matter.

(B) Similar analysis can be applied to claims 2, 4, 5, and 6. Therefore those claims are rejected for the same reasons as claims 1 and 3.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

Art Unit: 3626

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-2 and 74 are rejected under 35 U.S.C. 102(e) as being anticipated by Rizzo et al. (6,470,338).

(A) As per claim 74, Rizzo discloses a system for matching potential clients with professional services providers which meet their personalized criteria comprising (Abstract):

(a) means for identifying via a webpage a service provider (Fig. 3, col. 2 lines 49-65, col. 9 lines 18-42, col. 10 lines 7-43);

(b) means for receiving data entered by potential clients using data entry devices, said received data being indicative of criteria, and automatically comparing said received data to data stored in a storage medium to identify one or more suitable professional services providers based upon said criteria (Fig. 1B, col. 3 line 59 to col. 4 line 32, col. 6 lines 5-53, col. 9 lines 18-42, col. 10 lines 7-43);

(c) means for receiving a response from at least one responding identified service provider, wherein the response is in reply to the clients request (Fig. 1C, 7, col. 7 line 39 to col. 8 line 51), wherein the service provider has signed up with the system for a membership fee and the client is able to use the system to access information about the service provider (reads on "agreement to use a communication-enhancing system") (col. 3 line 59 to col. 4 line 21).

Art Unit: 3626

(B) As per claims 1-2, Rizzo discloses a method for matching potential clients with professional service providers comprising:

(a) generating email messages to send to a client identifying a service provider (col. 7 lines 20-38);

(b) accessing by the client the email messages having information about potential service providers (col. 7 lines 20-38);

(c) receiving a response from at least one responding identified service provider, wherein the response is in reply to the clients request (Fig. 1C, 7, col. 7 line 39 to col. 8 line 51), wherein the service provider has signed up with the system for a membership fee and the client is able to use the system to access information about the service provider (reads on "agreement to use a first service-enhancing system") (col. 3 line 59 to col. 4 line 21); and

(d) performing steps a-c by a second service provider, wherein the second service provider is not a registered member (reads on "using a second service-enhancing system having at least one feature absent from the first service-enhancing system (col. 7 lines 19-67).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 75 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rizzo et al. (6,470,338) in view of Thompson et al. (6,334,133).

(A) As per claim 75, Rizzo discloses a system for matching potential clients with professional services providers which meet their personalized criteria comprising (Abstract):

(a) means for identifying via a webpage a service provider (Fig. 3, col. 2 lines 49-65, col. 9 lines 18-42, col. 10 lines 7-43);

(b) means for receiving data entered by potential clients using data entry devices, said received data being indicative of criteria, and automatically comparing said received data to data stored in a storage medium to identify one or more suitable professional services providers based upon said criteria (Fig. 1B, col. 3 line 59 to col. 4 line 32, col. 6 lines 5-53, col. 9 lines 18-42, col. 10 lines 7-43); and

(c) means for providing by the service provider, such as a law firm or attorney, information about themselves including jurisdictions in which they practice, areas of expertise, size of the law firm, and email address (col. 3 line 59 to col. 4 line 11).

Rizzo does not explicitly disclose providing by the service provider certain minimum experience requirements, said experience requirements being more specific, or higher than those generally accepted or legally required to practice in the industry of said service provider. Thompson discloses a replacement worker providing information on their certifications, wherein some of the certifications are more than is needed to teach (Fig. 3, col. 3 lines 5-25, col. 8 lines 15-63). At the time the invention was made,

Art Unit: 3626

it would have been obvious to one of ordinary skill in the art to include the features of Thompson within the system of Rizzo with the motivation of ensuring that the position is filled by someone who is qualified to take on the role (Rizzo; col. 3 lines 5-25).

11. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rizzo et al. (6,470,338) in view of Minder (6,144,943).

(A) As per claim 3, Rizzo discloses a system for matching potential clients with professional services providers which meet their personalized criteria comprising (Abstract):

(a) identifying via a webpage a service provider (Fig. 3, col. 2 lines 49-65, col. 9 lines 18-42, col. 10 lines 7-43);

(b) receiving data entered by potential clients using data entry devices, said received data being indicative of criteria, and automatically comparing said received data to data stored in a storage medium to identify one or more suitable professional services providers based upon said criteria (Fig. 1B, col. 3 line 59 to col. 4 line 32, col. 6 lines 5-53, col. 9 lines 18-42, col. 10 lines 7-43); and

(c) providing by the service provider, such as a law firm or attorney, information about themselves including jurisdictions in which they practice, areas of expertise, size of the law firm, and email address (col. 3 line 59 to col. 4 line 11), wherein the service provider submits a response in reply to the clients request (Fig. 1C, 7, col. 7 line 39 to col. 8 line 51), wherein the service provider has signed up with the system for a

membership fee and the client is able to use the system to access information about the service provider (reads on "agreement") (col. 3 line 59 to col. 4 line 21); and

Rizzo does not explicitly disclose receiving an agreement from said service provider to adhere to certain standards of care in providing services to each client obtained as a result of said making said listing information available, said certain standards being more specific, or higher, than those generally accepted or legally required to practice in the industry of said service provider.

Minder discloses an agreement between a contractor to adhere to certain quality standards, wherein the standards can be more specific than those required in the industry (col. 4 lines 3-60).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Minder within the method of Rizzo with the motivation of ensuring the quality of the work (Minder; col. 1 lines 52-60).

(B) As per claims 4 and 6, the Examiner notes that Rizzo discloses providing by the service provider, such as a law firm or attorney, information about themselves including jurisdictions in which they practice, areas of expertise, size of the law firm, and email address (col. 3 line 59 to col. 4 line 11), wherein the service provider submits a response in reply to the clients request (Fig. 1C, 7, col. 7 line 39 to col. 8 line 51), wherein the service provider has signed up with the system for a membership fee and the client is able to use the system to access information about the service provider (reads on "agreement") (col. 3 line 59 to col. 4 line 21). Rizzo does not disclose the

Art Unit: 3626

agreement being to use a computer-software based process to assure that said service provider adheres to certain standards of care or the agreement from said service provider being to not pass on to any client any cost of using said computer software-based process. However, the differences between Rizzo and the prior art are only found in the nonfunctional descriptive material and are not functionally involved in the step recited. The step of receiving an agreement would be performed the same regardless of the terms of the agreement. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). For further guidance, note MPEP § 2106, common situations involving nonfunctional descriptive material are: "a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention."

(C) As per claim 5, Rizzo discloses a service provider paying a membership fee (col. 3 line 65 to col. 4 line 5).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches a consultant matching system and method for selecting candidates from a candidate pool by adjusting skill

Art Unit: 3626

values (6,289,340) and system and method for matching professional service providers with consumers (US 2002/0038233 A1).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

14. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Art Unit: 3626

Or faxed to:


(571) 273-8300	[Official communications]
(571) 273-8300	[After Final communications labeled "Box AF"]
(571) 273-6767	[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

CB

CB

October 5, 2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600